

REMARKS

In an office action dated 7 March 2003, the Examiner rejects claims 27-29 and 35-51 as well as objecting to the specification and drawings. In response to the office action, Applicants amend the specification and drawings and respectfully traverse the rejections to the claims. Claims 27-29 and 35-51. In light of the amendments and the below arguments, Applicants respectfully request that the Examiner allow all pending claims and allow this application.

The Examiner rejected the specification and drawings based on the use of "kernal." Applicants amend the specification to change kernal to kernel throughout the specification. Applicants also provide a red-lined change of Figure 2, changing kernal to kernel in the drawings. Formal drawings reflecting these changes will be filed when the application is allowed.

The Examiner rejects claim 27, 37, and 42 under 35 U.S.C. §102(b) as being anticipated by "RFC 2002: IP Mobility Support" by Perkins (Support). In order for anticipation rejection to be proper, each and every claim element of the claim must be found either expressly or inherently in a single prior art reference. See MPEP §2131. See also Verdegaal Bros. V. Union oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). In order to show an element is inherent in a reference, the Examiner must show extrinsic evidence. See MPEP §2131, See also Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991). This evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be recognized as so by persons of ordinary skill in the art. Id. The Examiner has failed to provide evidence that all claimed elements are expressly and or inherently in Support.

Claim 27 recites "A method for communication between a mobile computer terminal and a host computer in a system in which it is necessary for the mobile computer terminal to send a message to the host computer to avoid being disconnected, including the steps of: determining a particular time at which the mobile computer terminal is to send a message to the host computer to avoid being disconnected; programming a timer or clock to wake up the mobile computer terminal so that the mobile computer terminal can send the message at said particular time; entering a sleep mode; waking up due to the programming of the timer or clock; and sending the message at said particular time. Support cited by the Examiner does not teach any of the limitations of this claim.

Claim 27 recites entering a sleep mode. Support does not explicitly or inherently teach this limitation. There is no specific mention anywhere in Support of a mobile device entering a sleep mode. Examiner states that the sleep mode is inherent in Support from the following statement in section 1.2 of Support "Moreover, mobile nodes are likely to be battery powered, and minimizing power consumption is important. Therefore, the number of administrative message sent over the link by which the mobile node is directly attached to the Internet should be minimized, and the size of these messages should be kept as small as is reasonably possible."

As stated above, extrinsic evidence must show that the missing descriptive matter, in this case entering a sleep mode, is necessarily present in the reference and that it would be recognized as so by one skilled in the art. The above statement from the goals section of Support does not provide extrinsic evidence. The statement is a mere statement of a result. One skilled in the art would recognize that minimizing power consumption by minimizing message may be done in one of several ways and does not necessarily require entering a sleep mode. One could simply reduce the amount of required administrative messages,

reduce the number of applications being executed, or any of a number of other methods that include may or may not include using a sleep mode. In shot, the Examiner has provided a result that may be reached in any of a number of ways to show that Support inherently teaches entering a sleep mode. This is simply not true. In fact the case law cited by the Examiner shows the exact opposite, the case law shows a claimed element may be used to provide several different functions or results i.e. the brush in In re Casey being used for tape dispensing and a prior art brush supporting a band of material or the hair curler in In re Otto that holds hair waving material and a prior art curler holding a permanent wave solution. Furthermore, the cases cited by the Examiner relate to obviousness under 35 U.S.C. § 103 and not inherency of a function in a reference under 35 U.S.C. § 102. For this reason, the Examiner has failed to provide extrinsic evidence that Support inherently teaches a mobile device entering a sleep as required by the Statute, case law and the MPEP.

Following the Examiner's logic, once a goal or result is stated, all manners and configurations for achieving the results are taught in the art. This is simply not true. For example following the Examiner's logic a computer that is made of vacuum tubes would teach a computer made of transistors and integrated circuits that provides the same function.

Claim 27 also recites waking up due to the programming of the timer or clock. The waking of a computer is not explicitly or inherently in Support. As stated above, entering a sleep mode is not taught in Support. Thus, Support does not teach waking or coming out of the sleep mode for the same reason that entering a sleep mode is not taught.

Claim 27 also recites programming a timer or clock to wake up the mobile computer terminal so that the mobile computer terminal can send the message at said particular time. Even if Support teach entering and waking from sleep mode,

Support does not teach programming a timer or clock. The Examiner states that the definition of Lifetime on page 28 of Support. The definition of lifetime is a field in a registration request message sent by a mobile unit. This is not a teaching of a clock. At best, this may be considered to implicitly teach that a mobile unit has a timer, counter or other device that measures the time remaining of a registration. However, this is not a teaching of programming a clock to wake up a device to send the message at a particular time.

In order to send the message at a particular time, the computer may have to wake up several cycles earlier in order to start all processes needed to send a message. Furthermore, as stated above, Support does not teach entering a sleep mode or waking up the device to transmit the message at a particular time. Thus, this limitation is also not taught by support.

For the above reasons, the current 35 U.S.C. § 102(b) rejection is not proper and the rejection of claim 27 must be removed. Thus, Applicants respectfully request that claim 27 be allowed.

Claims 28-36 are dependent upon claim 27. Thus, claims 28-36 are allowable for at least the same reasons as claims 27 and all rejections to claims 28-36 should be removed. Therefore, Applicants respectfully request that claims 28-36 be allowed.

Claim 37 is a mobile computer terminal configured to perform the method of claim 27. Thus, claim 37 is allowable for at least the same reasons as claim 27 and the rejection to claim 37 should be removed. Therefore, Applicants respectfully request that claim 37 be allowed.

Claims 38-41 are dependent upon claim 37. Thus, claims 38-41 are allowable for at least the same reasons as amended claim 37 and the rejections to claims 38-41 should be removed. Therefore, Applicants respectfully request that claims 38-41 be allowed.

Claim 42 is rejected under 35 U.S.C. §103(a) over admitted prior art in view of Support. Claim 42 recite programming a timer to wake-up the unit in time to transmit a message to avoid being disconnected. This is not taught by the admitted prior art. This is also not taught by Support for the reasons given above with respect to claim 27. Thus, the combination of the admitted prior art and support do not teach this limitation. Therefore, the rejection to claim 42 must be removed. Applicants respectfully request that claim 42 be allowed.

Claims 43-46 are dependent upon claim 42. Thus, claims 43-46 are allowable for at least the same reasons as claim 42. Therefore, the rejections to claims 43-46 must be removed and Applicants respectfully request claims 43-46 be allowed.

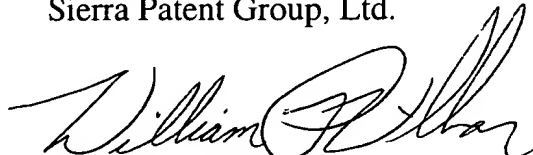
Claim 47 is the method performed by a device such as the device claims in claim 42. Thus, claim 47 is allowable for at least the same reasons as claim 42. Thus, the rejection to claim 47 should be removed and Applicants respectfully request claim 47 be allowed.

Claims 48-51 are dependent upon claim 47. Thus, claims 48-51 are allowable for at least the reasons as claim 47. Therefore, Applicants respectfully request that the rejections to claims 48-51 be removed and that claims 48-51 be allowed.

If the Examiner has a question about this response or the application in general, the Examiner is invited to telephone the Applicants at 775-586-9500.

Respectfully submitted,
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Dated: 09 June 2003



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